

REMARKS

Amendments have been made to the specification. Claims 2, 9, and 16 have been amended. No new matter has been introduced with these amendments, all of which are supported in the specification as originally filed. Claims 1 - 21 remain in the application.

I. Rejection under 35 U.S.C. §103(a)

Paragraph 4 of the Office Action dated June 23, 2005 (hereinafter, "the Office Action") states that Claims 1 - 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. 6,554,187 to Otto in view of U. S. 6,507,279 to Loof. This rejection is respectfully traversed.

With regard to independent Claims 1, 8, and 15, these claims specify a first limitation of "creating a unique correlator value, for a current transaction comprising a plurality of items being purchased together ..." (Claim 1, lines 3 - 4) and a second limitation of "storing the unique correlator value in an RFID tag affixed to each of the items ..." (Claim 1, line 5). The Office Action admits that "Otto fails to specifically teach or fairly suggest" these limitations. See p. 3, lines 7 - 8 of the Office Action. Applicants respectfully submit that Loof also fails to teach or suggest these limitations, as will now be discussed.

Loof teaches that a "member" has authorization to enter an access-controlled area for shopping (col. 2, lines 15 - 19, "An access control subsystem [is incorporated] to restrict access to a controlled area ... Entry to the controlled area is permitted only to an authorized member ..."). The authorized list of members is stored in a database (col. 2, line 16 - 17, "... database

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containing a list of authorized members.”). For these authorized members, Loof teaches that purchasing habits can be tracked while the member is in the access-controlled area (col. 2, line 24, “The member is [tracked] throughout the controlled area.”). The member’s information from the access control database can store the member’s purchasing habits (col. 2, lines 59 - 67), and this information can include such things as the date and time of the purchase (col. 2, lines 62 - 63) and/or the articles selected for purchase by the member (col. 2, line 66).

Loof teaches that the member’s purchasing habit information, stored in database 2, may be “correlated to date and time” (col. 4, lines 15 - 16). However, date and time does not provide a “unique correlator value, for a current transaction” (in contrast to Applicants’ Claim 1, line 3; emphasis added). Loof also teaches that a “customer’s prior purchases can be simply correlated to the customer’s present location [in the controlled shopping area]” (col. 6, lines 49 - 50). A customer’s location is also not a “unique correlator value, for a current transaction”.

Loof teaches that a purchased item having an RFID tag can have “[p]urchase information for that item ... written directly to the RFID tag [of the item] to designate that the item has been sold ...” (col. 4, lines 44 - 46). However, in contrast to the first limitation of Applicants’ independent Claims 1, 8, and 15, there is no teaching, nor any suggestion, in Loof that this “purchase information” is a “unique correlator value” created “for a current transaction”. In fact, Loof uses the term “purchase information” as a synonym for “method of payment”. See, for example, col. 4, lines 52 - 55, “Credit and purchase information 42 can be any selected method of payment ... or other method or combination of methods of payment”. See also col. 5, lines 48 -

52, discussing retrieval of the customer's "credit and purchase information" and "an opportunity to select an alternate payment method" when the customer decides to purchase items, as well as col. 6, lines 17 - 21, stating that the customer's "credit and purchase information ... will include the customer's preferred method of payment ...".

Lines 14 - 16 on p. 3 of the Office Action state, in discussing Loof, that "Since the customer's visit ... is also tracked, reading the purchase information from the [RFID] tag, the plurality of items can be grouped together by purchase date and time" (emphasis added). As noted above, purchase date and time does not yield a unique transaction correlator value: in a large store, a number of customers might purchase items simultaneously, in which case the date and time of purchase for transactions of these customers would be identical (i.e., not unique).

Page 3, line 21 - p. 4, line 2 of the Office Action states that "it would have been obvious ... to incorporate recording detailed purchase information into RFID tag to the teachings of Otto in order to provide retailers with accurate information regarding the items." (emphasis added). Applicants respectfully disagree with this characterization of the references. Loof does not teach any type of "detailed purchase information" that can fairly be construed as "a unique correlator value, [created] for a current transaction" (in contrast to Applicants' Claim 1, line 3).

Furthermore, a unique, transaction-specific correlator value (as specified in Applicants' claim language) does not necessarily "provide retailers with accurate information regarding the items [purchased]" (emphasis added). For example, the unique correlator value might be a long

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bit-string that provides no decipherable information other than to indicate, by comparison to another long bit-string, whether the bit-strings are identical. Applicants fail to see how this would "provide retailers with accurate information regarding the items".

Applicants therefore respectfully submit that the suggested combination of Otto's teachings with Loof's teachings fails to teach the limitations of Applicants' independent Claims 1, 8, and 15, and also respectfully submit that the supposed motivation provided on p. 3, line 21 - p. 4, line 2 of the Office Action is based on prohibited hindsight reasoning.

Page 4, lines 2 - 4 of the Office Action state that "Not only [would] the retailers need to know whether ... an individual item is purchased at their store, but they would want to know if a plurality of items ... were purchased at one transaction or not" (emphasis added). Applicants respectfully submit that there is no basis in the references (nor in the prior art in general) for this assertion. The quoted text from the Office Action refers to "a customer bring[ing] many items back for refund or exchange". Applicants respectfully submit that this is a mere assertion, unsupported by the references, which has been generated in hindsight. As stated by the Federal Circuit in *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Accordingly, Applicants respectfully submit that the supposed motivation provided on p. 4, lines

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2 - 4 of the Office Action is invalid for use in a §103 rejection.

Page 4, lines 4 - 6 of the Office Action state that "Perhaps, Otto provides, although not in a greatly detailed manner, provides [sic] transactional information such as purchase time and date, which could be interpreted as part of transaction ID". Applicants respectfully note that on the prior page of the Office Action, it has already been admitted that Otto does not "teach or fairly suggest" RFID tags containing a correlator value that could be used to indicate that a group of items was purchased together (e.g., in a particular transaction). Furthermore, Applicants' claim language does not specify creating "part of" a transaction ID (or "part of" a unique correlator value created for a current transaction). Applicants are entitled to have all words of their claim language considered when judging the patentability of their claims. (See Section 2143.03 of the MPEP, "All Claim Limitations Must Be Taught or Suggested", which makes reference to the holding from *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970), which stated "All words in a claim must be considered in judging the patentability of that claim against the prior art." (emphasis added).)

Thus, as has been demonstrated, neither Otto nor Loof nor a combination thereof yields the limitations of Applicants' independent Claims 1, 8, and 15. These claims are therefore deemed patentable over the references, as are their dependent Claims 2, 9, and 10.

With regard to Applicants' independent Claims 3, 10, and 17, these claims also specify limitations not taught nor suggested by Otto and/or Loof. The first limitation of these claims

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specifies “a unique, transaction-specific value” written in RFID tags of a plurality of items (Claim 3, lines 3 - 4). The Office Action admits that Otto fails to teach or suggest a correlator value which can indicate that a group of items was purchased together (e.g., in a particular transaction). See p. 3, lines 7 - 8 of the Office Action, which has been discussed above. Loof also fails to teach or suggest a “unique, transaction-specific value” written into RFID tags of a plurality of items, as has also been discussed above.

Furthermore, neither reference teaches nor fairly suggests the final limitation of Applicants’ independent Claims 3, 10, and 17, which specifies “concluding that selected ones of the items possessed by the shopper were potentially not paid for if the located correlator value [i.e., the correlator value located in the selected item’s RFID tag] ... is not identical to the located correlator value for the other possessed items” (Claim 3, lines 5 - 7, emphasis added). Neither Otto nor Loof has any suggestion of comparing information written in the RFID tag of one item possessed by a shopper to information written in the RFID tag of another item possessed by that shopper.

Thus, independent Claims 3, 10, and 17 are deemed patentable over Otto and Loof, whether taken singly or in combination. Dependent Claims 4 - 7, 11 - 14, and 18 - 21 are therefore deemed patentable over these references as well.

In view of the above, the Examiner is therefore respectfully requested to withdraw the §103 rejection of all claims.

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II. Conclusion

Applicants respectfully request reconsideration of the pending rejected claims, withdrawal of all presently outstanding rejections, and allowance of all claims at an early date.

Respectfully submitted,



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